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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/820,279

04/08/2004

Ray C. Wasielewski

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TAFT, STETTINIUS & HOLLISTER LLP

SUITE 1800

425 WALNUT STREET

CINCINNATI, OH 45202-3957

EXAMINER

COMSTOCK, DAVID C

ART UNIT

PAPER NUMBER

3733

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/820,279	<b>Applicant(s)</b> WASIELEWSKI, RAY C.	
	<b>Examiner</b> DAVID COMSTOCK	<b>Art Unit</b> 3733	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 March 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-91 is/are pending in the application.
- 4a) Of the above claim(s) 8-35,37-46,49,53-57,64-68,75-82,84,85 and 88 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7,36,47,48,50-52,58-63,69-74,83,86,87 and 89-91 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 July 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>05 August 2004</u> .  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election without traverse of claims 1-7, 36, 47, 48, 50-52, 54-74, 83, 85-87, 89-91, corresponding to a reamer and an inclinometer, in the reply filed on 26 March 2008 is acknowledged. It is noted that claims 9-22 have status indicators of "original"; therefore, if they were not withdrawn by Applicant, they are hereby withdrawn by Examiner as being drawn to a non-elected species and subspecies. In addition, claims 54-57 depend from withdrawn claim 53, and have accordingly been withdrawn from consideration. Finally, claims 64-68 and 85 have also been withdrawn as they are necessarily directed to the non-elected species of a prosthetic device. As such, claims 8-35, 37-46, 49, 53-57, 64-68, 75-82, 84, 85, and 88 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species and subspecies, there being no allowable generic or linking claim. Therefore, claims 1-91 are pending and claims 1-7, 36, 47, 48, 50-52, 58-63, 69-74, 83, 86, 87 and 89-91 are currently under consideration.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 87 and 90 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear what actual steps are encompassed by the term "associating." It is noted that "associating" could simply be a mental step and not require any physical transformation. See also the rejection under 35 USC 101, below.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 87 and 90 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claimed act of "associating" the claimed elements relative to each other does not require that any actual manipulative steps occur. As such, the claims can be construed as being directed to nothing more than intended mental steps with no physical transformation or acts. Accordingly, the claims are not within any statutory class of invention.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-7, 47-52, 58-63, 74, 83, 86, 87 and 89-91 are rejected under 35 U.S.C. 102(e) as being anticipated by Hunter et al. (2004/0152970 A1).

Hunter et al. disclose the claimed invention including a surgical device 170, a positional sensor 58, and a computer system (see, e.g. Figs. 1 and 6 and para. 0069). The surgical device is a reamer. The reamer includes a plurality of positional sensors thereon. The computer system includes the necessary circuitry and a display 10 for providing positional information. The claimed method is inherent in an ordinary use of the device.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hunter et al. (US 2004/0152970 A1) in view of Kienzie, III et al. (US 6,285,902 B1).

Hunter et al. discloses the claimed invention except for explicitly disclosing the use of inclinometers as one or more of the sensors. Kienzie, III et al. disclose a similar device and teach that inclinometers can be used to assist in determining an object's inclination from horizontal and facilitate an accurate surgical procedure (see, e.g. col. 14, lines 62-67). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided the system of Hunter et al. with an

inclinometer as one or more of the sensors, in view of Kienze, III et al., in order to assist in determining the reamer's position and to facilitate an accurate surgical procedure.

Claims 69-73 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hunter et al. (US 2004/0152970 A1)

Hunter et al. disclose the claimed invention except for explicitly reciting the use of multiple tools and sensors. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided multiple tools and sensors, e.g. to accommodate individual patient and/or surgical requirements, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Comstock whose telephone number is (571) 272-4710 (a detailed message should be left if Examiner is unavailable). If attempts to reach the Examiner by telephone or voicemail are unsuccessful, the examiner's supervisor, Eduardo Robert, can be reached at (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3733

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/David Comstock/  
Examiner, Art Unit 3733

/Eduardo C. Robert/  
Supervisory Patent Examiner, Art Unit 3733